

application of the present application, which was not traversed by Applicant. The Examiner further states that Applicant's arguments contending that "recapture" only applies to claims only broader than cancelled claims were not persuasive, as this was only one criteria for the applicability of recapture. The Examiner then cites *Pannu v. Storz Instrument, Inc.*, 59 U.S.P.Q. 2d 1597 (Fed. Cir. 2001) in support of his position that separate criteria are to be applied for application of the recapture rule. However, the Examiner provides no analysis as to the criteria set forth in *Pannu*.

Amendment in Parent Application was with Traverse

Contrary to the Examiner's statement, Applicant amended the claims in the parent application to overcome the rejection relating to the recapture rule *with traverse*.

More specifically, Applicant's response included the following language.

"In an Office Action of January 1, 2000, the Examiner also rejected Claims 6 - 22 under 35 U.S.C. §251. More particularly, the Examiner contended that the claims improperly recaptured claimed subject matter deliberately cancelled in the application for the patent upon which the present issue is based. The Examiner contended that the limitation "a payload located on the top portion of the telescopic mast" is omitted in the reissue claims, but was present in the claims of the original application. Applicant has amended the claims to overcome the rejection under 35 U.S.C. §251 **with traverse**. Applicant reserves the right to file a continuation application to the present reissue application."

If the Examiner requires a copy of Applicant's response including this quote, it will be duly provided.

### Improper Recapture Does Not Apply Under *Pannu*

It is clear that the Federal Circuit applies a variety of tests to determine application of the recapture rule. For example, *Ball Corp. v. United States*, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984) applies a rule wherein the recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. Meanwhile, *In Re Clement* 131 F.3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997) applied a separate three part rule which applied the following principles:

1. If the reissue claim is as broad or broader than the cancelled or amended claims in all respects, the recapture rule bars the claim;
2. If it is narrower in all respects, the recapture rule does not apply;
3. If the reissue claim is broader in some aspects, but narrower in others, then a) if the reissue claim is as broad or broader as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; b) if the reissue claim is narrower in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.

As explained in great detail in Applicant's previous response, applying either of these tests, the recapture rule is not applied and the claims of the present application are entitled to allowance.

Now, the Examiner cites *Pannu v. Storz Instrument, Inc.*, 59 U.S.P.Q. 2d 1597 (Fed. Cir. 2001) which sets forth a third test. However, even applying the *Pannu* test, Applicant is entitled to allowance of the claims.

*Pannu* applies a three step process for determining application of the recapture rule. The first step is to “determine whether and in what aspect the reissued claims are broader than the patent claims.” The second step is to “determine whether the broader aspects of the reissued claims related to the surrendered subject matter.” Finally, the Court must “determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule”. If the reissued claims included a narrowing aspect relating to their broadening, the recapture rule will not apply. This appears to be a restatement of the third principle of *In Re Clement* reflecting that a reissued claim may be broader in an aspect germane to the earlier prior art rejection if the reissued claims were narrowed in a material respect compared with their broadening. See *Pannu*, 59 U.S.P.Q. 2d at 1601.

A review of the instant application, the cancelled claims of the original application and the allowed claims of U.S. Patent No. 5,615,855 demonstrates that the recapture rule does not bar allowance of the reissued claims even under application of *Pannu*. Admittedly, the first two criteria for determination of the recapture rule are met. The reissued claims are broader than the patent claims, and the broader aspects of the reissued claims relate to surrendered subject matter. However, the third criteria indicates that the recapture rule does not apply.

Simply, Applicant has narrowed the claims in a “material respect compared with their broadening.”

The cancelled claim of the previous patent application is, by far, of the broadest scope, covering any telescoping mast assembly wherein a payload is located in the top section of the assembly, but also including constructions where the payload is in the bottom section, or in an intermediate section. The claim was narrowed, resulting in the only independent claim of U.S. Patent No. 5,615,855, which covers telescoping mast assemblies wherein the payload is located only in the top section of the mast assembly. Applicant realized after issuance of the patent that it had unduly narrowed the scope of the claim, as a claim would have been allowed directed to a telescoping mast assembly including a plurality of non-payload carrying intermediate sections (Claims 1 - 12) or directed to a telescoping mast assembly including at least one non-payload carrying intermediate section for protecting the payload section and an attachment means for attaching the telescoping mast assembly to a vehicle (Claims 13 - 17). Admittedly, the claims of the instant application are broader than the claims of the ‘855 patent, namely the payload section need not be positioned only in the uppermost section. However, Applicant has included narrowing limitations which directly relate to the broadening, namely the telescoping mast includes non-payload carrying intermediate sections. Thus, applying the *Pannu* test to its completion, the recapture rule does not apply.

Applicant would also like to reiterate that the recapture prohibition is *presumptively* avoided as to claims which are narrower in some respect to claims cancelled in the parent

application. *Ball Corp. v. United States*, 221 U.S.P.Q. at 295. Here, the reissued claims are narrower than the cancelled claims which permitted the payload to be located in any mast section. Thus, there is a presumption that the recapture rule does not apply.

### CONCLUSION

Applying the tests set out in *Ball Corp. v. U.S.*, *In Re Clement*, and even *Pannu v. Storz Instrument, Inc.* reflects that the recapture rule does not apply to bar allowance of the claims of the present application. Accordingly, notice thereof is respectfully solicited. Moreover, Applicant wishes to note that the issue fee was paid on October 24, 2000.

Respectfully submitted,

DRUMMOND & DUCKWORTH ✓



David G. Duckworth  
Registration No. 39,516  
Attorneys for Applicant  
Telephone: (949) 724-1255